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EXAMINER

ERB, NATHAN

ART UNIT

PAPER NUMBER

3639

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/083,298	Applicant(s) WADLEY, DONALD	
	Examiner Nathan Erb	Art Unit 3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☒ Claim(s) 32 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02-27-2002</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “200” has been used to designate both “output device” and “article.”

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: “50” (p. 7, line 18, and elsewhere). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities: On p. 14, line 10, please replace the word “invent” with --inventive--.

Appropriate correction is required.

Claim Objections

4. Claim 32 is objected to because of the following informalities: Claim 32 as written depends from claim 19, yet appears to have been intended to depend from claim 31. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 9 depends from claim 1, which mentions “a database” (line 4). Claim 9 also refers to “a database” in line 33. It is unclear if there is one or two databases involved. In addition, when claim 9 refers to “the database” (line 34), it is unclear if it is referring to a single database by itself or one of two databases (as well as which of the two databases, if there are two databases involved).

7. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 19 depends from claim 11, which mentions “a database” (line 8). Claim 19 also refers to “a database” in line 3. It is unclear if there is one or two databases involved. In

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addition, when claim 19 refers to “the database” (line 4), it is unclear if it is referring to a single database by itself or one of two databases (as well as which of the two databases, if there are two databases involved).

8. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 19 recites the limitation "the enabling step" in line 2. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 23 recites the limitation "the addressee indicator" in line 23. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 24 recites the limitation "the addressee indicator" in line 27. There is insufficient antecedent basis for this limitation in the claim.

11. Claims 31 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For purposes of this rejection, claim 32 is being interpreted as if it depends from claim 31, as that appears to be what was intended. Both claims are to “an article,” yet the claim limitations strictly describe only identifier and addressee information on the article. No description is given of the article itself sufficient to define what exactly the article is.

Claim Rejections - 35 USC § 101

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. Claims 31 and 32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. For purposes of this rejection, claim 32 is being interpreted as if it depends from claim 31, as that appears to be what was intended. Claims 31 and 32 describe the claimed articles exclusively by reference to information on the surface of the articles. This information constitutes nonfunctional descriptive material and is non-statutory under 35 U.S.C. 101. See MPEP 2106(IV)(B)(1)(b).

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 11, 13, 16-18, 21-23, 25, 27, and 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Moore, U.S. Patent No. 5,917,925.

As per **Claim 11**, Moore discloses a method for sending an article in a postal system, said method comprising the steps of:

- causing an identifier to be associated with address information in a database (column 5, lines 12-25, discloses causing an identifier to be associated with information in a database in

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general; column 7, lines 18-47, discloses the information being address [destination] information);

- marking an article with the identifier (column 7, lines 28-39);
- and comparing the address information associated with the identifier with addressee information on the article before delivering the article (column 7, lines 39-47).

As per **Claim 13**, Moore further discloses wherein the identifier is unique to the article (column 4, lines 59-65).

As per **Claim 16**, Moore further discloses:

- reading addressee information from the article (column 7, lines 18-47);

- and comparing the addressee information against address information associated with the identifier in the database (column 7, lines 18-47).

As per **Claim 17**, Moore further discloses signaling when information from the article fails to match corresponding information in a database (column 12, lines 25-42). Moore also discloses that information read from the article and compared to corresponding information from a database may include addressee information from the article (column 7, lines 18-47). Therefore, Moore further discloses signaling when the addressee information differs from the address information associated with the identifier in the database.

As per **Claim 18**, Moore further discloses maintaining records associated with the identifier comparing step (column 26, lines 6-12).

As per **Claim 21**, Moore discloses a system for tracking an article having an identifier (column 7, lines 23-39) and a recipient address (column 7, lines 39-47), said system comprising:

- a reader configured to read information from said article (column 5, line 64, through column 6, line 14);
- a database including identifier data associated with at least one identifier (column 6, lines 18-20);
- and means for retrieving data from the database and reviewing the data (column 6, lines 18-20; the indicia could not be validated unless the data could be retrieved from the database and reviewed).

As per **Claim 22**, Moore further discloses wherein said database further comprises data relating one or more identifiers to one or more recipient addresses (column 7, lines 18-47) and said system further comprises means for comparing the recipient address on said article against the identifier data in the database (column 7, lines 18-47).

As per **Claim 23**, Moore further discloses wherein said means for comparing the recipient address on said article comprises hardware configured to facilitate a comparison of the addressee indicator against the identifier data in the database (column 7, lines 18-47, discloses the described function; column 6, lines 15-28, discloses using computers (that is, hardware) to do the data comparison step of the invention).

As per **Claim 25**, Moore further discloses means for storing the results of the comparison of the recipient address against the identifier data in the database (column 27, lines 28-45).

As per **Claim 27**, Moore further discloses wherein said reader comprises means for reading the identifier on said article (column 5, line 64, through column 6, line 14).

As per **Claim 29**, Moore further discloses means for recording data in relation to operation of the system (column 26, lines 6-12).

As per **Claim 30**, Moore further discloses wherein said reader may read information which identifies a source of the article (column 7, lines 18-47; unique manufacturer identifier would indicate source).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 1-9, 14, 19, 26, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of Patchett, Sharon, "Efforts to Control Credit Card Fraud May Inconvenience Holder," Syracuse Herald Journal, City Edition, Syracuse, NY, May 12, 1997, p. C.2.

As per **Claim 1**, Moore discloses a method for sending an article in a postal system, said method comprising the steps of:

- causing an identifier to be associated with information in a database (column 5, lines 12-25);
- marking an article with the identifier (column 3, line 67, through column 4, line 3);
- and checking whether the identifier is enabled before delivering the article (column 4, lines 26-46).

Moore fails to disclose enabling the identifier after the occurrence of a predetermined event.

Patchett discloses enabling an identifier (a credit card number) after the occurrence of a

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predetermined event (consumer calling a toll-free number to activate the credit card) (p. 1, 3rd paragraph from bottom). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the article-mailing method of Moore such that the identifier is not enabled until after the occurrence of a predetermined event as disclosed by Patchett. Patchett provides motivation in that not enabling an identifier until after a predetermined event can help prevent fraudulent activity that might have otherwise occurred in the time period before the identifier was enabled (p. 1, 5th paragraph from bottom).

As per **Claim 2**, Moore further discloses wherein the identifier serves as postage for the article (column 5, lines 34-41). Moore and Patchett fail to disclose the article only being delivered when the identifier is enabled. However, it was well-known in the art at the time of applicant's invention that the postal service typically would not deliver articles without valid (that is, enabled) postage. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the article-mailing method of Moore as modified by Patchett above in this section such that the article would only be delivered when the identifier is enabled as was well-known in the art at the time of applicant's invention. Motivation is provided by the fact that it was well-known in the art at the time of applicant's invention that postage serves as payment to the postal service in exchange for delivering an article; therefore, it is only logical not to deliver articles with invalid postage (the identifier, in this case).

As per **Claim 3**, Moore further discloses wherein the identifier is unique to the article (column 4, lines 59-65).

As per **Claim 4**, Moore fails to disclose distributing the article in commerce before enabling the identifier. Patchett discloses distributing an article (a credit card) in commerce (all the way to the consumer) before enabling the article's identifier (having the consumer activate the credit card number) (entire article). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the article-mailing method of Moore as modified by Patchett above in this section such that the article is distributed in commerce before the identifier is enabled as disclosed by Patchett. Patchett provides motivation in that distributing the article in commerce before the article's identifier is enabled can help prevent fraudulent activity that might have otherwise occurred in the time period before the identifier was enabled (p. 1, 5th paragraph from bottom).

As per **Claim 5**, Moore and Patchett fail to disclose wherein said article is selected from the group consisting of magazine inserts and warranty cards. However, magazine inserts and warranty cards were well-known in the art at the time of applicant's invention as articles commonly intended to be mailed. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the article-mailing method of Moore as modified by Patchett above in this section such that the article could be a magazine insert or a warranty card as was well-known in the art at the time of applicant's invention. Motivation is provided by the fact that it was well-known in the art at the time of applicant's invention that magazine inserts and warranty cards often had postage paid by the intended addressee; therefore, they would be a possible target for those intending to misuse such postage arrangements and

potentially in need of the protection offered by the invention of Moore as modified by Patchett above in this section.

As per **Claim 6**, Moore further discloses:

- reading addressee information from the article (column 7, lines 18-47);
- and comparing the addressee information against address information associated with the identifier in the database (column 7, lines 18-47).

As per **Claim 7**, Moore further discloses signaling when information from the article fails to match corresponding information in a database (column 12, lines 25-42). Moore also discloses that information read from the article and compared to corresponding information from a database may include addressee information from the article (column 7, lines 18-47). Therefore, Moore further discloses signaling when the addressee information differs from the address information associated with the identifier in the database.

As per **Claim 8**, Moore further discloses maintaining records associated with the identifier comparing step (column 26, lines 6-12).

As per **Claim 9**, Moore fails to disclose wherein the enabling step involves including an indication within a database that the identifier is valid, such that a later check of the identifier within the database returns a result showing that the identifier is valid. Patchett discloses wherein the enabling step (the consumer activating the credit card number) involves including an

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indication within a database that the identifier is valid, such that a later check of the identifier within the database returns a result showing that the identifier is valid (This would inherently have to happen in the credit card activation process as described. The fact that the card was activated would have to be recorded in some sort of database, showing the credit card number [the identifier] as valid, so that the credit card company would be able to tell whether or not credit card transactions should go through when the credit card is used.) (p. 1, 2nd and 3rd paragraphs from bottom). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the article-mailing method of Moore as modified by Patchett above in this section such that the enabling step involves including an indication within a database that the identifier is valid and a later check of the identifier within the database returns a result showing that the identifier is valid, as disclosed by Patchett. Patchett inherently provides motivation in that this is an inherent step of the fraud-prevention system disclosed by Patchett, which has an intended purpose of preventing fraudulent use of items before their intended recipients can receive them (entire article).

As per **Claim 14**, Moore fails to disclose distributing the article in commerce before enabling the identifier. Patchett discloses distributing an article (a credit card) in commerce (all the way to the consumer) before enabling the article's identifier (having the consumer activate the credit card number) (entire article). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the article-mailing method of Moore such that the article is distributed in commerce before the identifier is enabled as disclosed by Patchett. Patchett provides motivation in that distributing the article in commerce before the

article's identifier is enabled can help prevent fraudulent activity that might have otherwise occurred in the time period before the identifier was enabled (p. 1, 5th paragraph from bottom).

As per **Claim 19**, Moore fails to disclose wherein the enabling step involves including an indication within a database that the identifier is valid, such that a later check of the identifier within the database returns a result showing that the identifier is valid. Patchett discloses wherein the enabling step (the consumer activating the credit card number) involves including an indication within a database that the identifier is valid, such that a later check of the identifier within the database returns a result showing that the identifier is valid (This would inherently have to happen in the credit card activation process as described. The fact that the card was activated would have to be recorded in some sort of database, showing the credit card number [the identifier] as valid, so that the credit card company would be able to tell whether or not credit card transactions should go through when the credit card is used.) (p. 1, 2nd and 3rd paragraphs from bottom). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the article-mailing method of Moore such that the enabling step involves including an indication within a database that the identifier is valid and a later check of the identifier within the database returns a result showing that the identifier is valid, as disclosed by Patchett. Patchett inherently provides motivation in that this is an inherent step of the fraud-prevention system disclosed by Patchett, which has an intended purpose of preventing fraudulent use of items before their intended recipients can receive them (entire article).

As per **Claim 26**, Moore fails to disclose means for enabling said identifier or means for verifying enablement of said identifier. Patchett discloses:

- means for enabling said identifier (The means is the customer calling the telephone number to activate [that is, enable] the identifier [the credit card number, in that case]; p. 1, 3rd paragraph from bottom);

- and means for verifying enablement of said identifier (This would inherently have to happen in the credit card activation process as described. The fact that the card was activated [that is, enabled] would have to be recorded in some sort of database, showing the credit card number [the identifier] as valid, so that the credit card company would be able to tell [that is, verify] whether or not credit card transactions should go through when the credit card is used.) (p. 1, 2nd and 3rd paragraphs from bottom).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the article-tracking system of Moore such that it included means for enabling the identifier and means for verifying the enablement of the identifier, as disclosed by Patchett. Patchett inherently provides motivation in that these are inherent elements of the fraud-prevention system disclosed by Patchett, which has an intended purpose of preventing fraudulent use of items before their intended recipients can receive them (entire article).

As per **Claim 31**, Moore discloses an article for use in a postal system, comprising:

- an identifier associated with an addressee, wherein said identifier is indicated on said article (column 7, lines 18-47);

- and said addressee being indicated on said article (column 7, lines 18-47; lines 45-47 disclose determining if the specified destination is correct; the “correct” destination is the one in the mass storage device which is also the one indicated by the identifier; the destination compared to that destination must presumably be one indicated on the article, separate from the identifier).

Moore does not disclose said identifier may alternate between being enabled and disabled in a database. Patchett discloses said identifier (a credit card number, in that case) may alternate between being enabled (activated) and disabled (not activated) in a database (a database of some sort is inherently disclosed because one would be needed to store information on whether each credit card number was activated or not so that the credit card company would know whether to allow any particular credit card transaction) (p.1, 2nd and 3rd paragraphs from bottom). It would have been obvious to one of ordinary skill in the art at the time of applicant’s invention to modify the article disclosed by Moore such that the identifier may alternate between being enabled and disabled in a database, as disclosed by Patchett. Patchett provides motivation in that not allowing an identifier to be enabled all the time can help prevent fraudulent activity that might have otherwise occurred during the time period in which the identifier was not enabled (p. 1, 5th paragraph from bottom).

18. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of Patchett in further view of Diamond, U.S. Patent No. 5,415,341. Moore further discloses

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delivering the article (column 11, line 10, mentions a “delivery point,” so a delivery step is implicitly disclosed). Moore and Patchett fail to disclose charging a payer for sending the article upon the delivery of the article. Diamond discloses charging a payer for sending the article upon the delivery of the article (column 1, lines 45-66). It would have been obvious to one of ordinary skill in the art at the time of applicant’s invention to modify the article-mailing method of Moore as modified by Patchett in section 17 above such that a payer would be charged for sending the article upon the delivery of the article as disclosed by Diamond. Diamond provides motivation in that “[t]he purpose of the Business Reply Envelope is to provide a postage paid method of response for a respoondee through the mail” (column 1, lines 58-61).

19. Claims 12, 15, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore.

As per **Claim 12**, Moore further discloses wherein the identifier serves as postage for the article (column 5, lines 34-41). Moore fails to disclose the article only being delivered when the identifier is enabled. However, it was well-known in the art at the time of applicant’s invention that the postal service typically would not deliver articles without valid (that is, enabled) postage. It would have been obvious to one of ordinary skill in the art at the time of applicant’s invention to modify the article-mailing method of Moore such that the article would only be delivered when the identifier is enabled as was well-known in the art at the time of applicant’s invention. Motivation is provided by the fact that it was well-known in the art at the time of applicant’s invention that postage serves as payment to the postal service in exchange for delivering an

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article; therefore, it is only logical not to deliver articles with invalid postage (the identifier, in this case).

As per **Claim 15**, Moore fails to disclose wherein said article is selected from the group consisting of magazine inserts and warranty cards. However, magazine inserts and warranty cards were well-known in the art at the time of applicant's invention as articles commonly intended to be mailed. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the article-mailing method of Moore such that the article could be a magazine insert or a warranty card as was well-known in the art at the time of applicant's invention. Motivation is provided by the fact that it was well-known in the art at the time of applicant's invention that magazine inserts and warranty cards often had postage paid by the intended addressee; therefore, they would be a possible target for those intending to misuse such postage arrangements and potentially in need of the protection offered by the invention of Moore.

As per **Claim 24**, Moore fails to disclose wherein said means for comparing the recipient address on said article comprises software configured to facilitate a comparison of the addressee indicator against the identifier data in the database. However, it was well-known in the art at the time of applicant's invention that software was commonly used to provide instructions to computers that allow them to perform their functions. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the article-tracking system of Moore such that software as was well-known in the art was used to compare the recipient

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address. Motivation is provided by the fact that it was well-known in the art at the time of applicant's invention that software was an effective way to direct a computer what to do.

20. Claims 20 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of Diamond.

As per **Claim 20**, Moore further discloses delivering the article (column 11, line 10, mentions a "delivery point," so a delivery step is implicitly disclosed). Moore fails to disclose charging a payer for sending the article upon the delivery of the article. Diamond discloses charging a payer for sending the article upon the delivery of the article (column 1, lines 45-66). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the article-mailing method of Moore such that a payer would be charged for sending the article upon the delivery of the article as disclosed by Diamond. Diamond provides motivation in that "[t]he purpose of the Business Reply Envelope is to provide a postage paid method of response for a respondee through the mail" (column 1, lines 58-61).

As per **Claim 28**, Moore fails to disclose means for charging a payer upon delivery of the article to the recipient of the article. Diamond discloses means for charging a payer upon delivery of the article to the recipient of the article (column 1, lines 45-66). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the article-tracking system of Moore such that it included means for charging a payer upon delivery of the article to the recipient of the article as disclosed by Diamond. Diamond provides

motivation in that “[t]he purpose of the Business Reply Envelope is to provide a postage paid method of response for a respondee through the mail” (column 1, lines 58-61).

21. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of Patchett in further view of Adams, U.K. Patent Application GB 2271452 A. (For purposes of this rejection, claim 32 is being interpreted as if it depends from claim 31, as that appears to be what was intended.) Moore further discloses wherein said identifier includes information which identifies a source of the article (column 7, lines 18-47; unique manufacturer identifier would indicate source) and said identifier is machine readable (column 5, line 64, through column 6, line 14). Moore and Patchett fail to disclose wherein said identifier is human-readable. Adams discloses wherein said identifier is human-readable (p. 18, lines 10-15). It would have been obvious to one of ordinary skill in the art at the time of applicant’s invention to modify the article of Moore as modified by Patchett in section 17 above such that the identifier is human-readable as disclosed by Adams. Adams inherently provides motivation in that the advantage of a human-readable identifier is that humans are able to read it, without the aid of machines (p. 18, lines 10-15).

Conclusion

22. **Examiner’s Note:** Examiner has cited particular portions of the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially

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teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

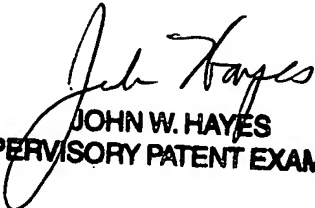
23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Erb whose telephone number is (571) 272-7606. The examiner can normally be reached on Mondays through Fridays, 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nathan Erb
Examiner
Art Unit 3639

nhe


JOHN W. HAYES
SUPERVISORY PATENT EXAMINER